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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,871	06/02/2004	Michael Zimmermann	LVIP112US	3870
24041 7590 09/19/2007 SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			EXAMINER MICHALSKI, SEAN M	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 09/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/709,871

Applicant(s)

ZIMMERMANN ET AL.

Examiner

Sean M. Michalski

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/06/2007 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Persson (US 3,103,844) in view of Yasanuga (US 5,748,366).

The Rejection will be discussed in terms of the amended limitations, all other limitations having been addressed in the Final action of 04/09/2007.

The limitation "wherein said pivoting device is enclosed within a curved rigid guide and mounted on the body of said observation device" is met by Yasunaga, as seen in figure 2; the pivoting device (comprised of elements 11, 14, 13) is "enclosed within a curved rigid guide" (7 is a curved rigid guide which encloses the pins of 11;

"13") and mounted on the body of said observation device (**4, 16 are the body of the observation device, to which 14, 11, 13 are clearly mounted/ affixed, joined and coupled**).

4. Claims 1-5, 8-10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Persson'844 in view of Yasunaga et al. (US 5,748,366) in further view of Staehle (US 4,277,133).

The Rejection will be discussed in terms of the amended limitations, all other limitations having been addressed in the Final Action of 04/09/2007.

The limitation "wherein said pivoting device is enclosed within a curved rigid guide and mounted on the body of said observation device" is met by Yasunaga, as seen in figure 2; the pivoting device (comprised of elements 11, 14, 13) is "enclosed within a curved rigid guide" (7 is a curved rigid guide which encloses the pins of 11; "13") and mounted on the body of said observation device (**4, 16 are the body of the observation device, to which 14, 11, 13 are clearly mounted/ affixed, joined and coupled**).

Again in claim 8, the limitation "arranged on a curved rigid guide enclosing the pivoting device and mounted on the body of said stereomicroscope." Is clearly met by the arrangement shown in Yasunaga, the pivoting device (comprised of elements 11, 14, 13) is "enclosed within a curved rigid guide" (7 is a curved rigid guide which encloses the pins of 11; "13") and mounted on the body of said observation device (**4,**

16 are the body of the observation device, to which 14, 11, 13 are clearly mounted/ affixed, joined and coupled).

As expressed previously, and in more detail, in the Final Action of 04/09/2007, the addition of detents does not give the claim any scrap of patentability, since detents are extremely old and well known mechanisms for relative retention, in predetermined positions.

5. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Persson'844 in view of in view of Yasunaga et al. (US 5,748,366) in further view of Persson'578 (USPN 3,405,578).

Persson'844 discloses, as discussed previously, a microtome (only figure) comprising a stereomicroscope (11) and pivoting device (10) and a positioning device (9) which positions the pivoting device. The apparatus as set forth is capable of performing all the functions required by the claim. The method of claims 9 and 12 recites that the elements above must be 'provided'; by their very presence they have been 'provided'. The step of pivoting is anticipated by column 2 line 23. It is noted that any angle the pivot moves to is 'defined', at least since all the angles are measurable.

Yasunaga discloses a different observation device (4 figure 3) which was pivotable on a curved rigid guide 7, which had a groove (8 figure 3), and the curved rigid guide encloses the pivoting device (11 and associated elements plus 14 and associated elements).

In the same field of problem solving endeavor it would have been obvious to one skilled in the art at the time of the invention to modify Persson'844 by replacing the pivot

structure with a curved rigid guide setup as taught by Yasunaga. The motivation to combine is that the pivot assembly of Yasunaga "enables the operator to easily observe the part to be or being operated on at every angle from every direction" (column 2 lines 53 and 54).

Persson'844 in view of Yasunaga et al. does not explicitly disclose that the positioning device includes a scale.

Persson'578 discloses a microtome having a scale (11 figure 2) indicating the position of a microscope in relation to the cutting edge of the blade.

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Persson'844 by providing the rotating microtome microscope with a scale as taught by Persson'578. The motivation to combine is that providing a scale allows the user to examine the quality of the knife. An additional motivation would be that in scientific experimentation repeatability is important, and so being able to record every parameter of a process (such as angle) will provide a more complete and credible data set.

Q 6. Claim 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Persson'844 in view of Yasunaga et al. (US 5,748,366) in further view of Staehle (US 4,277,133) as applied to claims 1-5 8-10 and 13 above, and in further view of Persson'578 (USPN 3,405,578).

Persson'844 in view of Yasunaga et al. (US 5,748,366) in further view of Staehle (US 4,277,133) discloses the method of claim 9, as discussed above.

Persson'844 in view of Yasunaga et al. (US 5,748,366) in further view of Staehle (US 4,277,133) does not explicitly disclose that the positioning device includes a scale.

Persson'578 discloses a microtome having a scale (11 figure 2) indicating the position of a microscope in relation to the cutting edge of the blade.

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Persson'844 by providing the rotating microtome microscope with a scale as taught by Persson'578. The motivation to combine is that providing a scale allows the user to examine the quality of the knife. An additional motivation would be that in scientific experimentation repeatability is important, and so being able to record every parameter of a process (such as angle) will provide a more complete and credible data set.

Regarding claim 11, whenever the arm of Persson'844 in view of Yasunaga et al. (US 5,748,366) in further view of Staehle (US 4,277,133) in further view of Persson'578 is moved, pivoting is accomplished to a defined position marking (see 11, of Persson'578; refer to column 2 lines 20-30).

Response to Arguments

1. Applicant's arguments filed 08/06/2007 have been fully considered but they are not persuasive.

In response to applicants allegation at page 8 of the remarks section, that "there must be some suggestion or motivation" to modify references in order to render the claim obvious, however The Supreme Court in *KSR International Co. v. Teleflex Inc. et al.* No. 04-1350, 550 U.S. ____ (2007), 82 USPQ2d at 1396, foreclosed the argument that a specific teaching suggestion or motivation is required to support a showing of obviousness. See the Board decision *Ex parte Smith* –USPQ2d–, slip op at 20, (Bd. Pat. App. & interf. June 25, 2007).

Applicant's assertion that "they fail together to teach all the limitations of claim 1," is without basis in fact or logical reasoning. Examiner has explicitly treated each claim limitation, above and in the final action of 4/09/2007.

Applicants assertion that curved rigid guide of Yasanuga (7) is in fact "within" 11 is false, since 13, a component of the pivoting device is contained within the rails of 7. This meets the limitations of the claim. Furthermore, **assuming arguendo that this is not the case**, the pivoting device with the opposite arrangement (that is observation device fixed to a curved rigid guide which may then be pivoted) **would also be held as a matter of law obvious**, since it is the mere reversal of parts, analogous to "*In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955) (Prior art disclosed a clock fixed to the stationary steering wheel column of an automobile while the gear for winding the clock moves with steering wheel; mere reversal of such movement, so the clock moves with wheel, was held to be an obvious expedient.)" which is cited at MPEP 2144.04 VI (A).

Regarding the allegation that there is no suggestion to modify, however as seen above, there is no requirement of such for a proper obviousness rejection. Secondly, it is obvious to replace the pivoting arrangement of the '844 patent with the Yasunaga pivot since they are both pivots used to rotate a stereomicroscope and are therefore art recognized equivalents. Using one art recognized equivalent in place of another is routine, within the level of ordinary skill in the art and is held to be obvious.

As seen in the above discussion, applicants sole argument; that Yasunaga teaches "the opposite" of the claimed invention, is not persuasive. So too, therefore are the arguments that depend on the underlying assumption that Yasunaga fails to teach something that is in fact readily apparent. None of the dependent claims are argued with respect to their separate limitations, and the only arguments present have been clearly found to be wholly unpersuasive.

Conclusion


¶. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMM



KENNETH E. PETERSON
PRIMARY EXAMINER